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REMARKS

Claims 151-245 are currently pending in the application. No new matter has been added.

During a telephonic interview between the undersigned attorney and the examiner on October 11, 2006, the prior art references of Hoyle (US 6,141,010), Yoneda (US 6,785,740) and McBrearty (IS 6,848,077) were discussed with reference to the currently pending claims. No specific agreement was reached.

Claims 151-160, 163-170, 173-191, 193-204, 207-215, 217-234 and 236-241 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,141,010 to Hoyle in view of U.S. Patent No. 6,785,740 to Yoneda et al. and U.S. Patent No. 6,848,077 to McBrearty et al. This rejection is respectfully traversed for various reasons. At least some of these reasons have been presented in prior responses and are part of the existing prosecution history. Additional reasons for traversal of the examiner's various rejections are presented below.

First, it is respectfully asserted that the examiner's stated motivation for combining the teachings of Hoyle and Yoneda is improper since there is no teaching or suggestion in either Hoyle or Yoneda which would motivate one having ordinary skill in the art to combine of the teachings of Yoneda with Hoyle as suggested by the examiner. More specifically, on page 4 of the office action, the examiner asserts that one would have been motivated combine the teachings of Yoneda and Hoyle in order to provide the user with access [via the dynamically marked-up hyperlink] to as much additional information (i.e. other banner ads in Hoyle) he/she may be interested in as possible, without detracting from the original document or distracting the user. However, there appears to be no teaching or suggestion in either Hoyle or Yoneda which supports the modification as suggested by the examiner. Rather, it is submitted that the Examiner's cited reasoning for combining Yoneda and Hoyle is derived using impermissible hindsight reconstruction, and at best, appears to be an assertion of an obvious to try rationale.

It is well established by the courts that the motivation to modify the prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989) ("[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification") (quoting *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)). Furthermore, whether a particular combination might be 'obvious to try' is not a legitimate test of patentability." (*In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596 (Fed. Cir.

1988)) MPEP Section 2143.01 also states that the prior art must suggest the desirability of the claimed invention.

Although the examiner states that Yoneda suggests such motivation, applicant respectfully asserts that there does not appear to be any teaching or suggestion in either Hoyle or Yoneda for the motivation as suggested by the examiner. Accordingly, applicant respectfully requests that the examiner cite to the specific text in Yoneda or Hoyle which teaches or suggests such motivation.

Additionally, it is noted that the test under 35 U.S.C. Section 103 is not whether an improvement or a use set forth in a patent would have been obvious or nonobvious; rather the proper test is whether the claimed invention, considered as a whole, would have been obvious. (*Jones v. Hardy*, 110 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984)). It is impermissible to focus on specific differences between the claimed invention and the prior art, (*Jones*, 220 U.S.P.Q. at 1024).

Further, it is well established that each of the prior art references must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention, or argue against obviousness. (*W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)) It is impermissible within the framework of Section 103 to pick and choose from a reference only so much of it as will support a conclusion of obviousness to the exclusion of other parts necessary to a full appreciation of what the reference fairly suggests to one skilled in the art. (*Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448-49, 230 U.S.P.Q. 416, 420 (Fed. Cir. 1986)).

In the instant case, it is submitted that the examiner is not considering the teachings of each of the prior art references as a whole, but rather is picking and choosing only those portions of the cited prior art references which support the examiner's position, while ignoring other portions of the cited prior art references which argue against obviousness and/or against motivation for combining the references as suggested by the examiner.

For example, when viewed as a whole, the teachings of Hoyle are directed to a software application implemented on a client computer system in which advertisements are displayed sequentially in a banner advertisement window (e.g., 78, Figure 5) either in response to some user action (input) or, in the absence of user input, are displayed periodically at timed intervals. The client software application monitors the user's inputs to the computer and, when possible, targets the banner advertising displayed so that it relates to the what the user is doing. (Hoyle 14:42-45) Associated with each banner advertisement is a set of data (e.g., Hoyle Figure 7) that is used by the software application in determining when a particular banner is to be displayed.

This includes the specification of certain programs that the user may have so that, when the user runs the program (such as a spreadsheet program), an advertisement will be displayed that is relevant to that program (such as an advertisement for a stock brokerage). (Hoyle Abstract).

For example, according to Hoyle 15:18-28, and referring to Figure 7, if the user were to direct his or her browser to "www.lotus.com/123", the ADM module 54 of Hoyle would display the "banner01.gif" image. The associated programs column [e.g., of the table of Figure 7] is similar in that execution of one of the specified applications (rather than a visit to a web site) will result in an associated banner being displayed.

Thus, when viewed as a whole, Hoyle teaches the desirability of monitoring a user's actions at a client computer (e.g., mouse clicks, launched applications, URL requests, etc.), and, based upon such actions, displaying ads in banner window 78 (Figure 5) which relate, presumably, to what the user is currently doing at the client computer.

The examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the dynamic keyword markup functionality of Yoneda to Hoyle's system and method so as to mark up additional keywords in Hoyle's documents with links to Hoyle's corresponding banner ads. Applicant respectfully disagrees. Nowhere does Hoyle appear to teach or suggest the desirability of marking up or otherwise modifying keywords in Hoyle's documents with links to corresponding banner ads; nor does Hoyle teach or suggest the desirability of modifying the content of web pages or other documents which are to be displayed to the user. In fact, it is believed that one having ordinary skill in the art would interpret Hoyle such that, rather than intrusively modifying the content or formatting of document text which is to be displayed to the user, Hoyle teaches the desirability of using a non-intrusive banner ad to display advertisements to the user without interfering with or altering the content or formatting of document text being displayed to the user.

Further, the examiner asserts that one would have been motivated to combine the teachings of Yoneda with that of Hoyle in order to provide the user with access [via the dynamically marked-up hyperlink] to as much additional information (i.e. other banner adds in Hoyle) he/she may be interested in as possible, without detracting from the original document or distracting the user. Applicant respectfully disagrees. First, it is noted that the nature and general purpose of inserting banner advertisements (such as those as taught in Hoyle) is to distract the user so that the attention of the user is at least temporarily focused on the banner advertisement. Thus, because Hoyle teaches an advertising technique which is intended to detract from the original document and which is intended to distract the user, it is respectfully asserted that the examiner's suggested motivation for combining Hoyle and Yoneda is improper.

Second, as illustrated, for example, in figure 5 of Hoyle, Hoyle teaches the desirability of displaying, at any given time, a single banner ad within a single banner ad window 78. Had Hoyle intended to display multiple banner advertisements to the user at any given time, it would have been a simple matter for Hoyle to disclose an embodiment which included multiple banner ad windows for displaying multiple simultaneous advertisements. However, there appears to be no teaching or suggestion in Hoyle of the desirability for displaying multiple simultaneous advertisements to the user at any given time.

In fact, Hoyle teaches quite the opposite, namely that it is desirable to display a single advertisement to the user at any given time. For example, as stated in Hoyle 15: 20-22, where multiple banners are associated with the same link (e.g., a URL that has been requested by a user), the ADM module 54 determines which of the banners should be selected based upon another criteria such as number of times each banner has previously been displayed. Thus, when viewed as a whole, it is believed that Hoyle teaches away from the proposed motivation suggested by the examiner of providing the user with access to as much additional advertising information as possible.

Moreover, the examiner has apparently overlooked the fact that the dynamic keyword markup functionality of Yoneda would be inoperable with many of the proposed embodiments of Hoyle. For example, as stated previously, if the user were to direct his or her browser to "www.lotus.com/123", the ADM module 54 of Hoyle would display the "banner01.gif" image. In this example, selection of the appropriate advertisement is based upon a user action (e.g., directing his or her browser to "www.lotus.com/123") rather than being based on keywords which are identified in the content of a document being displayed to the user. Accordingly, the dynamic keyword markup functionality of Yoneda would be inoperable in such a situation since there would be no corresponding "text" to be marked up. Similarly, in another embodiment described in Hoyle, when the user runs a program (such as a spreadsheet program), an advertisement may be displayed that is relevant to that program (such as an advertisement for a stock brokerage). In this example, selection of the appropriate advertisement is also based upon a user action (e.g., the launching of a spreadsheet application) rather than being based on keywords which are identified in the content of a document being displayed to the user, and the dynamic keyword markup functionality of Yoneda would again be inoperable in such a situation since there would be no corresponding "text" to be marked up. Accordingly, it is submitted that, when viewed as a whole, one of ordinary skill in the art would not be motivated to combine the dynamic keyword markup functionality of Yoneda with the system of Hoyle since Yoneda's

dynamic keyword markup functionality would be inoperable in many of the proposed embodiments of Hoyle.

On page 16 of the office action, the examiner asserts that McBrearty is used solely to show common knowledge implementation details for ignoring non-searchable HTML elements in a text search process. However, in doing so, the examiner is choosing to ignore other teachings in McBrearty which teach away from the claimed invention.

It is noted that one aspect of the present claimed invention is directed to a context-based advertising technique in which selected text from a web page (which is to be displayed on a client system) is identified, marked up, and linked to additional information relating to the advertiser's product. As a result, the web page which is displayed to the user on the client system may include additional hyperlinks which were generated using the context-based advertising technique of the present invention.

In contrast, McBrearty is directed to a technique for providing a user with a means for predetermining subject matter, terms and words for which the user desires to have hyperlinks in a received Web document. In this way, McBrearty provides a technique for allowing a user to display in the received Web document, multiple hyperlinks for each predetermined term of interest to thereby substantially reduce the user's browsing through several levels of Web documents in pursuit of topics of interest.

For example, McBrearty 1:45-2:5 states:

Web documents or pages have hyperlinks setting forth terms and topics which the user may interactively click on or select to access other Web documents which, in turn, respectively have their own hyperlinks selectable by the user to access the next Web documents. Thus, browsing through Web documents often involves the time consuming process of following a thread of hyperlinked Web documents through several levels of hyperlinks, then backing up to a Web document at an earlier level, selecting another hyperlink in that document and then following another thread of hyperlinked documents through several levels.

Web developers and users are continually seeking implementations to make this Web document browsing process less cumbersome and more user friendly.

SUMMARY OF THE PRESENT INVENTION

The present invention addresses these user needs by providing the user and developer with an implementation providing the user with a means for predetermining subject matter, terms and words for which the user desires to have hyperlinks in a received Web document. It further provides for displaying in the received Web document, multiple hyperlinks for each predetermined term of interest to thereby substantially reduce the user's browsing through several levels of Web documents in pursuit of topics of interest.

From this teaching it is clear that one problem to be solved in McBrearty is the ability to make Web document browsing process less cumbersome and more user friendly. One solution proposed by the technique of McBrearty is to allow the user to restrict the display of hyperlinks of a retrieved webpage to subject matter, terms and words selected by the user. As a result, the technique of McBrearty teaches away from the technique of the present invention since, for example, McBrearty is directed to a technique for limiting or reducing displayed hyperlinks in a web document to those relating to subject matter, terms and words selected by the user, while at least one embodiment of the present claimed invention is directed to a technique for generating additional displayed hyperlinks in a web document relating to keywords or categories selected by an advertiser.

Further it is submitted that McBrearty teaches away from the teachings of both Hoyle and Yoneda. For example, both Hoyle and Yoneda are also directed to advertising techniques in which a portion of a document is analyzed using selected keyword information that has been provided by the advertiser. If it is determined that the document includes text relating to the selected keyword information, additional information (e.g., advertising related information) may be displayed to the user. However, McBrearty specifically teaches away from the techniques of both Hoyle and Yoneda by explicitly teaching that the user is provided with a means for predetermining subject matter, terms and words for which the user desires to have hyperlinks in a received Web document. (see e.g., McBrearty 1:62-67, 6:7-21)

Based at least upon this evidence, it is submitted that, when considered in its entirety as a whole, one having ordinary skill in the art would not be motivated to combine the teachings of McBrearty with that of Hoyle or Yoneda.

Moreover, even if one were to combine the teachings of McBrearty with that of Hoyle or Yoneda, the resulting device would realize the same features and/or benefits as defined, for example, in claim 151 (and/or other claims) of the present claimed invention. For example, because McBrearty is directed to a technique for limiting or reducing displayed hyperlinks in a web document to those relating to predefined words and terms of interest selected by the user, even if text in the web document were identified as being related to advertiser keyword information, the identified text would not be marked up as a hyperlink and displayed to the user unless such identified text also related to the predefined words and terms of interest selected by the user, as required by the explicit teaching of McBrearty.

Accordingly, it is believed that, when considered in its entirety as a whole, the combining of the teachings of McBrearty with that of Hoyle, Yoneda would result in a device which would not realize the same features and/or benefits as defined, for example, in claim 151 of the present

claimed invention. Should the examiner disagree, Applicant's attorney wishes to seek further clarification from the examiner on this issue, by way of telephonic interview.

Independent claims 186, 195, 229, 237, 240 and 241 include language defining one or more features which are similar to those defined in claim 151. Accordingly, it is submitted that claims 186, 195, 229, 237, 240 and 241 are neither anticipated by or obvious in view of the cited prior art references, and are therefore believed to be allowable. Additionally, each of the presently pending dependent claims is also believed to be allowable since it depends upon a respective independent claim.

The additional limitations recited in the independent claims or the dependent claims are not further discussed as the above-discussed limitations are clearly sufficient to distinguish the claimed invention from the cited prior art references, either separately or in combination thereof.

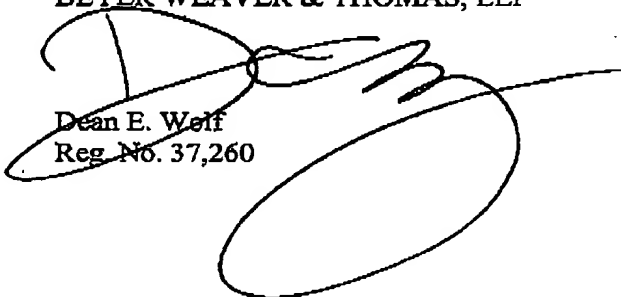
Because claims 151-245 are believed to be allowable in their present form, many of the examiner's rejections in the Office Action have not been addressed in this response. However, applicant respectfully reserves the right to respond to one or more of the examiner's rejections in subsequent amendments should conditions arise warranting such responses.

Applicants believe that all pending claims are allowable. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,

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